

REMARKS

Summary of the Office Action

The Examiner rejected claims 1-3, 6-11, 14-19, and 22-25 under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,266,640 to Fromm (hereinafter “Fromm”) in view of U.S. Patent Publication No. 20030154139 to Woo (hereinafter “Woo”).

In the claims:

Claims 1, 9, 17, and 25 are currently amended; Applicant respectfully submits that no new matter has been added.

Claims 2, 3, 6-8, 10, 11, 14-16, 18, 19, and 22-24 are previously presented.

Claims 4, 5, 12, 13, 20, 21, and 26-30 are cancelled.

Applicant's Reply - Claim Rejections Under 35 U.S.C. § 103

Claims 1-3, 6-11, 14-19, and 22-25 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Fromm in view of Woo. Applicant respectfully traverses the rejections of record.

Independent claim 1 is directed to a method for conducting a secure transaction and has been amended to include the elements of, *inter alia*:

providing payment account information associated with said payment account via a telephone call, said payment account information to be used for conducting said transaction;

transmitting an authentication request, formatted according to the 3-D Secure authentication protocol, including said payment account information to an issuer server.

Independent claim 9 has similarly been amended to include the elements of, *inter alia*:

receiving payment account information associated with said payment account via a telephone call, said payment account information to be used for conducting said transaction; and

transmitting an authentication request, formatted according to the 3-D Secure authentication protocol, including said payment account information to an issuer server, said authentication request triggering automatically by said server a telephone call to said holder.

Independent claim 17 has similarly been amended to include the elements of,

inter alia:

receiving payment account information associated with said payment account via a telephone call, said payment account information to be used for conducting said transaction; and

receiving an authentication request, formatted according to the 3-D Secure authentication protocol, including at least said payment account information in connection with conducting said transaction.

Independent claim 25 has similarly been amended to include the elements of,

inter alia:

wherein said automated voice response subsystem receives an authentication request and transmits an authentication response, wherein said payment account information is provided via a telephone call and further wherein said authentication request and said authentication response are formatted according to the 3-D Secure authentication protocol.

To reject claims in an application under Section 103, an examiner must establish a *prima facie* case of obviousness. Using the Supreme Court's guidelines enunciated in *Graham v.*

John Deere, 383 U.S. 1, 17 (1966), one determines "obviousness" as follows:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

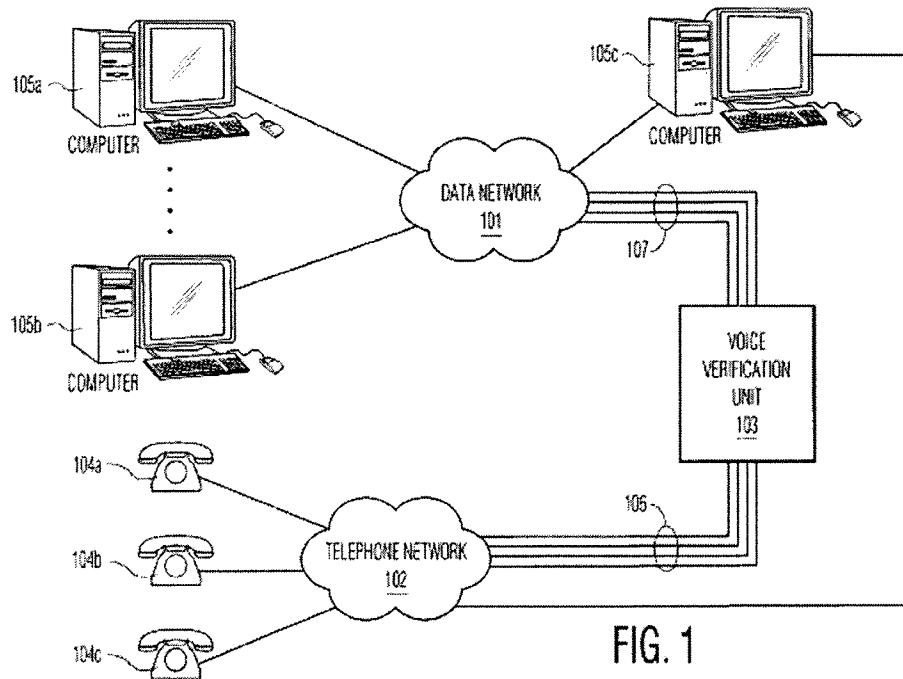
In *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350 (U.S. April 30, 2007), the Supreme Court reaffirmed the *Graham* test, and indicated that although it should not be

rigidity applied, a useful test for determining obviousness is to consider whether there is a teaching, suggestion or motivation in the prior art that would lead one of ordinary skill in the art to combine known elements of the prior art to arrive at the claimed invention. Importantly, the Court emphasized that a patent examiner's analysis under Section 103 should be made explicit in order to facilitate review.

Thus, to establish a *prima facie* case of obviousness, the Examiner has an obligation to construe the scope of the prior art, identify the differences between the claims and the prior art, and determine the level of skill in the pertinent art at the time of the invention. Therefore the Examiner must (1) provide an explicit, cogent reason based on the foregoing why it would be obvious to modify the prior art to arrive at the claimed invention (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations.

Assuming, *arguendo*, that the combination of Fromm and Woo was proper, the combination fails to disclose or suggest each of the claim limitations. Fromm is directed to a technique for verifying a user's voice in conducting a business transaction over a computer data network, such as the internet. (See Fromm, col. 1, lines 14-15 and col. 1 line 55 - col. 2 line 4). The technique involves retrieving a user's voice print from a voice print bank based on the user's ID which is ascertained from his computer data network address. (See Fromm, col. 1, lines 61-63). As shown in Figure 1 of Fromm, which is reproduced below for the Examiner's convenience, the data network 101 includes and plurality of computers 105a, 105b, and 150c separate from the telephone network 102 which includes a plurality of phones. Fromm, however, fails to disclose providing payment account information via a telephone call as Applicant's amended claim 1 requires. Instead, in Fromm, the payment account information is

provided via the computer data network by transmission from computer 105a. (See Fromm, col. 2, lines 59-65 and col. 3, lines 8-12). Therefore, Fromm does not disclose providing payment account information associated with said payment account via a telephone call.



The Examiner agrees that Fromm is silent with respect to the payment account information associated with the payment account is provided via telephone, but alleges that Woo cures this deficiency because “a payment request may be initiated by the wireless device 230 (which may include cellular telephones and PDAs).” (See, Office Action, page 4). Applicant, however, has amended claim 1 to clarify that the payment account information is provided via a telephone call. As the Examiner agrees at page 4 of the Office Action, Woo teaches a method for conducting an electronic commerce transaction, but Woo does not disclose or suggest providing payment account information via a telephone call. (See, Office Action, page 4 and Woo, abstract). Instead, in Woo, the electronic commerce transaction is conducted from a wireless device using the input devices including keyboards, mice, and trackballs. (See, Woo,

paragraph [0026]). In any event, payment account information is not provided via the telephone as the credit card number is instead looked up in an e-wallet which is stored during registration with the m-commerce infrastructure. (*See*, Woo, paragraph [0029]). Therefore, Fromm and Woo, either alone or in combination, do not disclose or suggest providing payment account information associated with said payment account via a telephone call.

Additionally, Fromm does not disclose or suggest formatting an authentication request according to the 3-D secure authentication protocol. The Examiner admits, at page 4 of the office action, that Fromm is silent with respect to formatting the authentication request according to the 3-D secure authentication protocol. The Examiner argues that it would have been obvious to incorporate the 3-D secure protocol of Woo into the system of Fromm. However, the Examiner fails to provide an explicit, cogent reason and there is no suggestion or motivation in either reference to combine the two. Applicant's invention, for example, is an improvement over the known techniques of Fromm and Woo which requires the modification of the 3-D secure protocol to include the telephone number associated with the payment account such that voice authentication can take place. (*See* Application, paragraph [0020]).

Therefore, the combination of Fromm and Woo is not proper, and even assuming, arguendo, that it was, Fromm and Woo, either alone or in combination, fail to disclose or suggest each limitation of independent claims 1, 9, 17, and 25. Thus claims 1, 9, 17, and 25 are patentable over the cited art and are in condition for allowance.

Claims 2-3, 6-8, 10, 11, 14-16, 18, 19, and 22-24 depend, directly and indirectly, from one of independent claims 1, 9, and 17. Therefore, claims 2-3, 6-8, 10, 11, 14-16, 18, 19, and 22-24 include all of the limitations of the independent claims from which they depend, in addition to the limitations recited in each individual dependent claim. Accordingly, because the


independent claims are allowable over the cited art, claims 2-3, 6-8, 10, 11, 14-16, 18, 19, and 22-24 are also allowable for at least the same reasons applicable to independent claims discussed above.

Furthermore, dependent claims 2-3, 6-8, 10, 11, 14-16, 18, 19, and 22-24 recite additional features not disclosed or suggested by the prior art of record. For example, claims 7, 15, and 23 include the additional element that the authentication request includes at least a device category data field, an authentication request channel data field, a cardholder phone number data field and a voice channel transfer method data field. The wording of these claims requires the authentication request includes all of a device category data field, an authentication request channel data field, a cardholder phone number data field, and a voice channel transfer method data field and not just at least one of them. The portion of Fromm cited by the Examiner (col. 3, lines 16-32; *See* Office Action, page 3) does not disclose each of a device category data field, an authentication request channel data field, a cardholder phone number data field and a voice channel transfer method data field and Woo does not cure the deficiencies of Fromm in this respect. Therefore, claims 7, 15, and 23 are patentable over the cited art for at least this additional reason.

CONCLUSION

In view of the foregoing amendments and remarks, favorable consideration and allowance of claims 1-3, 6-11, 14-19, and 22-25 as amended is respectfully solicited. Applicant hereby authorizes the Commissioner to charge payment of any additional fees or credit any overpayment associated with this communication to Deposit Account No. 02-4377. In the event that the application is not deemed in condition for allowance, the Examiner is invited to contact the undersigned in an effort to advance the prosecution of this application.

Respectfully submitted,


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